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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME  
2003 SOUTH EASTON RD  
SUITE 208  
DOYLESTOWN, PA 18901

EXAMINER

SALCE, JASON P

ART UNIT PAPER NUMBER

2623

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/749,255	<b>Applicant(s)</b> FLICKINGER, GREGORY	
	<b>Examiner</b> Jason P. Salce	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5, 10-12 and 28-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-12 and 28-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 3/22/2006 have been fully considered but they are not persuasive.

Applicant argues that Alexander fails to teach that IPG ads are stored in an ordered list and that Alexander only teaches that more than one virtual channel ad may be stored in RAM and therefore, items in RAM are inherently not stored in an ordered list. The examiner disagrees and notes that a RAM is inherently capable of storing items in memory slots that have been allocated to store the ads. Alexander is silent as to what type of order the ads are stored in, however, even if the ads are randomly stored, items that are randomly stored are stored in random order. Therefore, because the RAM stores ads, the storage of the ads are clearly in a particular type of ordered list, whether the order is random, consecutive, or by genre, all of these storage methods comprises a particular order.

Applicant also notes that the Examiner considers the grid guide, the virtual ad channel, the EPG hard page, the PIP window, or the ad window that the user sees to be equivalent to an IPG ad queue. The examiner disagrees and notes that the RAM that stores the ads to be displayed is what the Examiner considers to be the IPG ad storage. The examiner further notes that the previous Office Action also is clear that Alexander only teaches a storage means for the IPG ads, and does not specifically teach a queue data structure to store the ads (which is clearly taught by Hite).

Applicant also argues that because Alexander's prioritized ads are not associated with the entire IPG, but rather are associated with only a specific page of section of the EPG that Alexander does not teach an IPG ad queue. Again note that that the previous Office Action is clear that Alexander only teaches a storage means for the IPG ads, and does not specifically teach a queue data structure to store the ads (which is clearly taught by Hite). Further note that independent claim 28 states nothing about an IPG ad queue having to store data for an entire EPG. Applicant is not even clear what an entire EPG is defined to be (3 hours of stored data or 1 month worth of stored data?) let alone recite such limitations in claim 28.

Applicant further argues that Alexander cannot teach displaying IPG ads in accordance with the IPG ad queue, because Alexander does not teach an IPG ad queue. Again note that that the previous Office Action is clear that Alexander only teaches a storage means for the IPG ads, and does not specifically teach a queue data structure to store the ads (which is clearly taught by Hite).

Applicant further argues that Alexander does not teach reordering the IPG ad queue in accordance with the displayed programming ad. In addition to Column 19, Lines 13-37, the examiner also notes Column 26, Lines 30-56, which again details that ads can be dynamic and displayed in order. Further note in this passage that Alexander clearly teaches at Lines 45-46 that, "different ads can appear each time the user enters the same page/section of the Guide" and at Column 26, Line 57 through Column 27, Line 2 for the EPG ads being reordered according to what the viewer is currently watching, therefore reordering the ads stored in RAM when displayed to the viewer in a

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particular order. Further note the example in this passage, which states that when a Toyota programming ad is displayed, then the EPG can be timed to display a correlative Toyota advertisement in some portion of the EPG. Again note that that the previous Office Action is clear that Alexander only teaches a storage means for the IPG ads, and does not specifically teach a queue data structure to store the ads (which is clearly taught by Hite).

Applicant also argues that Alexander does not focus on the order of linked EPG items and that Alexander does not teach an order for linked EPG items at all. Again note Column 26, Line 57 through Column 27, Line 2 for providing an order for EPG ads.

Applicant also argues that Alexander never suggests that the ads are reordered or that they are reordered in respect to the displayed programming ads. The examiner again disagrees and notes the arguments above for Alexander reordered the EPG ads according to the programming ad being displayed. Again note that that the previous Office Action is clear that Alexander only teaches a storage means for the IPG ads, and does not specifically teach a queue data structure to store the ads (which is clearly taught by Hite).

Applicant also argues that there is no motivation to combine Alexander and Hite by stating that the two inventions are too divergent and that since Alexander teaches showing a particular ad window and PIP window combination based on the item in the EPG that is currently selected, while Hite teaches showing a particular programming ad based on the profile of the user as stored in the "Consumer Database". The examiner disagrees and notes that Applicant is not considering the combination of the features of

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Alexander and Hite specified in the previous Office Action. Alexander stores EPG ads and links the ads according to the programming ad being displayed and that the EPG ads are simply stored in a RAM, no mention of the specific memory storage structure is discussed. The only teaching used from Hite is that a queue can be used to store EPG ads. Therefore, it would be obvious to make the combination of Alexander and Hite, to improve the efficiency of Alexander's RAM by organizing the ads into a particular storage structure in order to provide a more efficient access method.

Applicant also argues that if Alexander and Hite are combined, Hite changes the mode of operation of the primary reference. The examiner disagrees and notes the rebuttal to the arguments made in regards to the combination of Alexander and Hite having no motivation to combine, which clarifies how Alexander is being modified in view of Hite. The examiner fails to see how the modification of the RAM to organize data into a queue structure changes the mode of operation of the Alexander reference, in fact, the examiner notes that this is an improvement to the storage means provided by Alexander.

Therefore the previous rejection stands and this Office Action is made Final.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 3/22/2006 was filed after the mailing date of the Non-Final Rejection on 12/19/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Response to Arguments***

3. Applicant's arguments filed 10/3/2005 have been fully considered but they are not persuasive.

Applicant has amended the independent claims to recite the limitation "***to be inserted in a programming avail***", which reads on the actual display of a commercial that is not displayed in an EPG, but commercial ads that are displayed during a television broadcast program. Although Alexander clearly discloses the linking of the EPG ads and all programs, commercials/ads displayed in the PIP window (see Column 19, Lines 24-37), Alexander does not disclose how commercials that are displayed in between television programs are stored in a queue for future display during a television broadcast. The examiner notes that Hite of record teaches this limitation by the use of an AD Queue in memory 616 (see Figure 6 and Column 12, Lines 15-21).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 12, 28-33, 38 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (U.S. Patent No. 6,177,931) in view of Hite et al. (U.S. Patent No. 6,002,393).

Referring to claim 28, Alexander discloses storing IPG ads (see Column 5, Lines 5-8), the IPG ads being stored in an ordered list (see Column 5, Lines 13-15).

Alexander also discloses linking at least one IPG ad with at least one programming ad (commercial) to form at least one IPG-programming ad combination (see Column 19, Lines 24-37 for displaying a sports program in a PIP that represents a television program (news advertising or sports programming/ads) and a related advertisement in the Ad Window).

Alexander also discloses displaying one or more IPG ads from the at least one IPG-programming ad combination in the IPG when the IPG is invoked immediately prior to or immediately subsequent to the display of a programming ad, wherein the IPG ads are displayed in accordance with the IPG ad stored (see again Column 19, Lines 24-37 for displaying a sports program in a PIP that represents a television program (news advertising or sports programming/ads) and a related advertisement in the Ad Window).

Alexander also discloses reordering the IPG ad stored in accordance with the displayed programming ad (see Column 19, Lines 13-37 for displaying information in the virtual ad channel and ad window when a sports or news channel is selected, therefore, if a different channel is selected different information in these areas are displayed and are therefore, inherently reordered). Also note Column 22, Line 19 through Column 23, Line 33 for more examples of reordering the IPG ads for display in virtual ad slots.



Alexander fails to disclose the specific memory structure of a queue to store the IPG and programming ads, as well as programming ads that are to be inserted in a programming avail.

Hite discloses the use of keeping data (specifically advertisements) in an Ad Queue of memory 616 (see Column 12, Lines 15-18), as well as using this Ad Queue to control which commercial are displayed/inserted in a programming avail (see Column 12, Lines 18-21). The examiner notes that by the use of the programming avail of Hite, which uses an ordered list of programming ads to be inserted into a programming avail, and the PIP window of Alexander, when the PIP window of Alexander displays a program, the Ad window will display an advertisement related to the program, and when the PIP window shows a programming ad (news story), the Ad window will show an advertisement related to the programming ad.

It would have been obvious to a person of ordinary skill in the art, to modify the virtual ad channel and ad window storage, as taught by Alexander, using the Ad Queue, as taught by Hite, for the purpose of targeting commercials to those particular consumers who represent only the best prospects for an advertiser (see Column 1, Lines 50-52 of Hite).

Referring to claim 10, Alexander discloses the interactive IPG ad allows a viewer to request additional information regarding a particular linked IPG ad including directly accessing a website via an EPG ad (col. 27, lines 19-47; col. 17, line 48 – col. 18, line 12).

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Referring to claim 12, Alexander discloses the IPG ad is displayed in the IPG when the IPG is invoked during the presentation of one of the programming ads col. 26, line 61 – col. 27, line 2).

Referring to claim 29, see the rejection of claim 28 for displaying information in the virtual ad channel and ad window when a sports or news channel is selected, therefore, if a different channel is selected different information in these areas are displayed and are therefore, inherently reordered (see Column 19, Lines 13-37).

Referring to claim 30, Alexander teaches that the ads are displayed to advertise further information about a broadcast program (see Column 17, Lines 44-67 and Column 18, Lines 1-32).

Referring to claims 31-32, see the rejection of claims 28-29, respectively.

Referring to claim 33, see the rejection of claim 30.

Referring to claims 38 and 40, see the rejection of claims 10 and 12, respectively.

Referring to claims 41-42, see the rejection of claim 28 for the reordering of the IPG ads based on what channel is selected by the user, which dictates which IPG ads to display and further note Hite for teaching that ads can be stored in a queue data structure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-3, 5, 34-35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (U.S. Patent No. 6,177,931) in view of Hite et al. (U.S. Patent No. 6,002,393) further view of Hendricks et al. (U.S. Patent No. 6,738,978).

Referring to claim 2, although Alexander and Hite suggest targeted advertisements, Alexander and Hite fail to specifically disclose wherein at least one of the IPG ads or at least one of the programming ads is a targeted ad, thus forming a targeted-IPG programming ad combination, as claimed.

However, Hendricks, in an analogous art, teaches targeted advertising wherein programming ads are targeted ads, and further, the targeted advertising routine incorporates subscriber groups with selected targeted advertisements assigned to groups of subscribers (Fig. 17; col. 35, line 65 – col. 36, line 28; col. 37, line 1 – col. 38, line 55) for the benefit of utilizing viewer demographic information and viewing habits to determine those advertisements that are of the most interest to particular viewers (see col. 4, lines 48-51 and col. 5, lines 30-35).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the IPG-programming ad combination of Alexander and Hite to incorporate at least one of the programming ads is a targeted ad, thus forming a targeted IPG-programming ad combination, as taught by Hendricks for the benefit of utilizing viewer demographic information and viewer habits to determine

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those advertisements that are of the most interest to particular viewers in a television advertising system.

The limitations of claim 3 are encompassed by the teachings of Alexander in view of Hendricks, as discussed above relative to claim 2. Specifically, Hendricks teaches assigning advertisements to at least one subscriber group, the subscriber group comprising at least one subscriber (col. 38, lines 15-36).

The limitations of claim 5 are encompassed by the teachings of Alexander in view of Hendricks, as discussed above relative to claim 3. Specifically, Hendricks teaches discloses assigning programming ads to one or more subscriber groups (see Hendricks at (Fig. 17; col. 35, line 65 – col. 36, line 28; col. 37, line 1 – col. 38, line 55). Alexander discloses forming an IPG-programming ad combination when the broadcast ad is displayed and the EPG is invoked during the display of the broadcast ad (see Alexander at col. 26, line 61 – col. 27, line 2). Thus, the IPG-programming ad combination is formed subsequent to the assignment of the programming ad to a subscriber group.

Referring to claims 34-35 and 37, see the rejection of claims 2-3 and 5, respectively.

6. Claims 4 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (Alexander), U.S. Patent No. 6,177,931 in view of Hite et al. (Hite), U.S. Patent No. 6,002,393 in further view of Hendricks et al (Hendricks), U.S. Patent No. 6,738,978, as applied to claim 3, further in view of Esch, U.S. Patent No. 5,283,639.

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As for claim 4, the teachings of Alexander in view of Hite in further view of Hendricks are relied upon as discussed above, relative to claim 3. Alexander in view of Hite in further view of Hendricks fails to disclose the targeted IPG-programming ad combination is formed prior to the assignment of the combination to one or more subscriber groups, as claimed.

However, Esch, in an analogous art, teaches combining elements (text, audio, graphic overlays, etc.) of an advertisement prior to assignment of the advertisement to a targeted group (col. 11, lines 11-66; col. 8, line 42 – col. 9, line 17). The process of combining elements with advertisement data is analogous to the claimed procedure for combining the IPG ad element with the broadcast ad element. The motivation to combine the above teaching of Esch is to customize advertising communications at a remote site to combine content data signal with locally (e.g., local broadcast facility) originated content data signals (see col. 1, lines 58-64).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the targeted IPG-programming ad combination taught by Alexander in view of Hite in further view of Hendricks to incorporate the targeted IPG-programming ad combination is formed prior to the assignment of the combination to one or more subscriber groups, as taught by Esch, for the benefit of customizing advertising communications at a remote site to combine content data signals with locally originated content data signals in a television advertising system.

Referring to claim 36, see the rejection of claim 4.

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7. Claims 11 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (Alexander), U.S. Patent No. 6,177,931 in view of Hite et al. (Hite), U.S. Patent No. 6,002,393 in further view of Boylan, III et al. (Boylan), U.S. Patent No. 6,799,326.

Referring to claim 11, the disclosure of Alexander and Hite are relied upon, as discussed above relative to claim 28. Alexander and Hite fail to disclose a viewer interaction with said IPG ad causes a related linked programming ad to be subsequently displayed.

However, Boylan, in an analogous art, teaches interactive IPG ads wherein the user selects a first (global) IPG advertisement and a second (local) ad, related and linked to the first ad, is subsequently displayed (Fig. 13; col. 7, line 65 – col. 8, line 56, disclosing global and local advertisement data; col. 9, line 62 – col. 10, line 19, describing presentation of local advertisement subsequent to selection of global ad (i.e., local ad is related and linked to the selected global ad) for the benefit of providing additional local advertising information tailored to the particular region of the viewer (see col. 8, lines 4-7).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the interactive IPG advertisements of Alexander and Hite to incorporate a viewer interaction with said IPG ad causes a related linked programming ad to be subsequently displayed, as taught by Boylan, for the benefit of providing additional local advertising information tailored to the particular region of the viewer.

Referring to claim 39, see the rejection of claim 11.

### ***Conclusion***

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce  
Primary Examiner  
Art Unit 2623

June 7, 2006

A handwritten signature in black ink, appearing to read "Jason Salce", is written over the printed name and title.